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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,363	09/28/2005	Earl C. Downey	01630-21317.PCT.US	3075

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EXAMINER	
HORNBERGER, JENNIFER LEA	
ART UNIT	PAPER NUMBER
3734	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/551,363	DOWNEY, EARL C.	
	Examiner	Art Unit	
	JENNIFER L. HORNBERGER	3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *01/03/2006, 02/08/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 9-14, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cuny (US 5,626,608).

Regarding claim 1, Cuny et al. disclose a surgical device, comprising: an ergonomic handle (16) having a finger actuator (28) configured to receive a single finger of a user; an elongated tubular portion (14) extending from the ergonomic handle and having a longitudinal axis, the finger actuator being positioned substantially in line with the longitudinal axis of the tubular portion (at least the top portion of the finger actuator is substantially in line with the longitudinal axis); and a rod (42) functionally disposed within the tubular portion along the longitudinal axis, the rod being coupled proximally to the finger actuator and configured to be coupled distally to a functional end (46, 48).

Regarding clam 2, Cuny et al. disclose a functional end (46, 48) coupled to a distal end of the rod, such that bidirectional pressure applied by the single finger to the finger actuator along the longitudinal axis manipulates the functional end in a bidirectional manner in a common direction to the bidirectional pressure (col. 5, ln. 65 - col. 6, ln. 6).

Regarding claim 3, Cuny et al. disclose a ratcheting mechanism (26) to lock the finger actuator in a fixed position, thus locking the functional end in a fixed position (col. 5, ln. 8-12).

Regarding claim 4, Cuny et al. disclose the functional end is free to rotate around the longitudinal axis (col. 6, ln. 46-52; Fig. 2).

Regarding claim 6, Cuny et al. disclose the ergonomic handle has a shape of a pistol grip.

Regarding claim 9, Cuny et al. disclose the functional end is selected from the group consisting of a grasper, scissors, a blade, a laser and a needle holder (col. 3, ln. 38-40).

Regarding claim 10, Cuny et al. disclose the functional end is a grasper (col. 3, ln. 38-40).

Regarding claim 11, Cuny et al. disclose the functional, end is scissors (col. 3, ln. 38-40).

Regarding claim 12, Cuny et al. disclose a surgical system operated by a single finger, comprising: an ergonomic handle (16) having a finger actuator (28) configured to receive a single finger of a user; an elongated tubular portion (14) extending from the ergonomic handle and having a longitudinal axis, the finger actuator being positioned substantially in line with the longitudinal axis of the tubular portion (at least the top portion of the finger actuator is substantially in line with the longitudinal axis); and a rod (42) functionally disposed within the tubular portion along the longitudinal axis, the rod being coupled proximally to the finger actuator and coupled distally to a functional end (46, 48), such that bidirectional pressure applied by the single finger to the finger actuator along the longitudinal axis manipulates the functional end in a bidirectional manner in a common direction to the bidirectional pressure (col. 5, ln. 65 -col. 6, ln. 6).

Regarding claim 13, Cuny et al. disclose a ratcheting mechanism (26) to lock the finger actuator in a fixed position, thus locking the functional end in a fixed position (col. 5, ln. 8-12).

Regarding claim 14, Cuny et al. disclose the functional end is free to rotate around the longitudinal axis (col. 6, ln. 46-52; Fig. 2).

Regarding claim 16, Cuny et al. disclose the functional end is selected from the group consisting of a grasper, scissors, a blade, a laser and a needle holder (col. 3, ln. 38-40).

Regarding claim 17, Cuny et al. disclose the functional end is a grasper (col. 3, ln. 38-40).

Regarding claim 18, Cuny et al. disclose the functional, end is scissors (col. 3, ln. 38-40).

3. Claims 1, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Cuschieri et al. (US 6,077,286).

Regarding claim 1, Cuschieri et al. disclose a surgical device, comprising: an ergonomic handle (4,3) having a finger actuator (4) configured to receive a single finger of a user; an elongated tubular portion (1) extending from the ergonomic handle and having a longitudinal axis, the finger actuator being positioned substantially in line with the longitudinal axis of the tubular portion; and a rod (6) functionally disposed within the tubular portion along the longitudinal axis, the rod being coupled proximally to the finger actuator and configured to be coupled distally to a functional end (2).

Regarding claim 6, Cuschieri et al. disclose the ergonomic handle has the shape of a pistol grip (Fig. 3).

Regarding 7, Cuschieri et al. disclose a portion of the pistol grip that is substantially out of line with the longitudinal axis can be manipulated into a position that is substantially in line with the longitudinal axis (Fig. 1-3).

4. Claims 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Blake (US 5,281,220).

Regarding claim 19, Blake discloses a method of manipulating a surgical instrument with a single finger, comprising the following steps: grasping the surgical instrument with a hand of a user; inserting the single finger of the user into a finger actuator of the surgical instrument; moving the single finger in a direction away from the hand, causing operation of a functional end; and moving the single finger in a direction toward the hand, causing operation of the functional end.

Regarding claim 20, Blake discloses a method of manipulating a surgical instrument with a single finger further comprising the step of rotating the functional end with the single finger.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cuny et al. (US 5,636,608) in view of Livneh (US 5,718,714).

Regarding claim 5, Cuny et al. discloses the claimed invention except for the elongated tubular portion is detachable from the ergonomic handle. Livneh discloses a surgical instrument

having a removable elongated tubular portion (34) provides the advantage providing access to all areas of the instrument for cleaning and sterilization. Additionally, it provides the ability to exchange working handles and functional end members (col. 5, ln. 4-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the inventions to make the tubular portion detachable from the handle as taught by Livneh to provide the ability to interchange functional members or handles and to disassemble the instrument for cleaning and sterilization.

Regarding claim 8, Cuny et al. discloses the claimed invention except for the portion of the pistol grip that is substantially out of line with the longitudinal axis is detachable. Livneh discloses a surgical instrument having an elongated tubular portion (34) detachable from the pistol grip which can also be interpreted as a pistol grip detachable from the elongated tubular portion. Livneh suggests that making parts of the instrument detachable from each other provides the advantage providing access to all areas of the instrument for cleaning and sterilization. Additionally, it provides the ability to exchange working handles and functional end members (col. 5, ln. 4-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the inventions to make the whole pistol grip (including the portion out of line with the longitudinal axis) detachable from the tubular portion as taught by Livneh to provide the ability to interchange functional members or handles and to disassemble the instrument for cleaning and sterilization.

Regarding claim 15, Cuny et al. discloses the claimed invention except for the elongated tubular portion is detachable from the ergonomic handle. Livneh discloses a surgical instrument having a removable elongated tubular portion (34) provides the advantage providing access to all areas of the instrument for cleaning and sterilization. Additionally, it provides the ability to exchange working handles and functional end members (col. 5, ln. 4-11). Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the inventions to make the tubular portion detachable from the handle as taught by Livneh to provide the ability to interchange functional members or handles and to disassemble the instrument for cleaning and sterilization.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlh
6/17/08

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3731